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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,503	02/02/2001	Dale Blackson	D-1132 R	9612

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EXAMINER

ALPERT, JAMES M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,503

Applicant(s)

BLACKSON ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/2/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The following communication is in response to Applicant's election and remarks filed on August 02, 2005.

Response to Arguments

Applicant's election with traverse of Group 1, Claims 1-54 and 83-86 in the reply filed on 08/02/05 is acknowledged. The traversal is on several grounds, and the Examiner finds persuasive the argument that the Office has not necessarily made the restriction requirement in a timely manner. Equity would indicate that all claims be examined given the entirety of the prosecution history in terms of timeliness and the numbers of actions promulgated. Therefore, the restriction requirement is hereby withdrawn.

The Examiner has not considered Applicant's arguments relating to serious burden, distinctness, rejoinder, and sufficiency.

Status of Claims

The prosecution history shows that the Office received amended claims on June 23, 2003. The amended claims were in response to a non-final rejection, mailed April 10, 2003. The records at the Office reflect that these were the last set of amended claims received. Although the Office promulgated an additional final rejection and non-final rejection, no changes to the claims have been made subsequent to June 23, 2003. The Examiner is under the impression that the claims received on June 23, 2003 are in the form that have been listed in the two appeal briefs filed 1/7/2004 and 6/23/2004. If

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Applicant is aware that this is incorrect, please contact the Examiner by phone to discuss this immediately.

In terms of the status of Applicant's appeal, PROSECUTION IS HEREBY REOPENED. Applicant's arguments with respect to Claims 1-86 have been considered but are moot in view of the new grounds of rejection, which are set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

New Grounds of Rejection

Claim Rejections - 35 USC §'s 112/101

MPEP §2173.05(p) states:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph: In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551. 2173.05(q) "Use" Claims Attempts to claim a process without setting forth any steps involved in the process.

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Claims 55-81 are rejected under 35 USC §'s 112/101 on the grounds discussed above, as such, appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by De Leo, U.S. Patent #6381626.

With regard to Claims 1-2, Deleo teaches a network of ATM machines configured for playing digital files over a video system with amplified sound. As such it teaches the following limitations:

at least one computer processor;
(Col. 4, lines 52-67)

at least one data store in operative connection with the computer processor, wherein
(Col. 4, lines 52-67)

the computer processor is operative to cause a plurality of digital information files to be retrieved from at least one digital information source located remotely from the machine and saved in the data store; (Col. 4, lines 8-32, wherein the description of the bandwidth requirements for transmitting MPEG files (digital files) is indicated)

at least one input device in operative connection with the computer processor;

a cash dispenser device in operative connection with the computer processor,
(Col. 10, lines 30-34)

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wherein the computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first input through the at least one input device (a card reader; (Col. 10, lines 30-34, and this is inherent to an ATM machine)

and at least one output device in operative connection with the computer processor, (Col. 10, lines 30-34, which discusses dispensing messages. Col. 3, lines 50-56 discusses how the message files are MPEG files)

wherein the computer processor is operative to cause the dispense of at least one of the digital information files through the at least one output device (Col. 10, lines 30-34, which discusses dispensing messages. Col. 3, lines 50-56 discusses how the message files are MPEG files)

responsive to at least one second input through the at least one input device (Col. 7, lines 5-46, which discusses a card input and additional user information input)

that corresponds to the at least one digital information file (selection is of a file) . (Col. 3, lines 50-56)

With regard to Claims 18-20, DeLeo teaches a local data store with access to a network for acquiring remote information. (Col. 9, lines 25-36; Col. 4, lines 8-32)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7,13-35,45-54,77,83-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Leo in view of Martin, U.S. Patent #5930765. Claims 8-12,36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Leo in view of Martin and further in view of Lotspiech, U.S. Patent #6748539. Claims 55-76 and 78-82

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are rejected under 103 as their corresponding apparatus claims, and are distributed accordingly.

With regard to Claims 3-6, De Leo fails to explicitly teach digital songs, a sound system, and a licensing fee. Martin on the other hand does teach the idea of entertainment jukeboxes with remote access to songs over a network. As such, Martin teaches those limitations relating specifically to digital songs and a sound system. See (Martin, Col. 4, lines 40-58). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of De Leo, relating to an ATM apparatus capable of storing and dispensing digital media, with the teachings of Martin, related to a sound system with digital songs being stored. The motivation for such a combination is to perfect De Leo so the quality of the sound reproduced is much higher.

Further although Martin doesn't discuss MP3 files or licensing fees, these are old and well known in the art, and would be an obvious modification, if not inherent aspect of a DeLeo/Martin combination.

With regard to Claim 7, every element of this claim is the same as in Claim 1, with the exception of a fee authorization input, and the delivery of content to different entities. Fee authorization is taught by Martin at (Col. 5, lines 12-17) while it is old and well known that any jukebox has a mean for accepting payment, and as well, any jukebox is accessed by any number of individuals each wanting to hear different songs. As such, this claim is rejected under DeLeo/Martin combination that could be combined under the same rational as in Claims 3-6.

With regard to Claims 8-12, a DeLeo/Martin combination does not specifically address the situation wherein the content is downloaded to a portable device. However this limitation is found in Lotspiech, which describes in detail how a digitized content can be downloaded to a portable device. See (Lotspiech, Col. 2, lines 7-51). Further, it would have been obvious to one of ordinary skill in the art at the time applicant's invention made to modify a DeLeo/Martin combination to include portable device as taught by Lotspiech. The motivation for such a combination is that by adding a feature such as portability, the system can be made to accommodate those individuals who have disabilities and are not able to make use of the apparatus in a public setting.

With regard to Claims 13-17, these features are all inherent properties of a DeLeo/Martin combination which includes a device responsive to insertion of a card, which then allows for the digital file to be played or displayed, as an output function, followed by a corresponding debit to the users account. This is exactly the purpose of an ATM configured to include a jukebox apparatus.

With regard to Claims 18-25, a DeLeo/Martin combination teaches the elements of these claims in a variety of way. Both DeLeo and Martin demonstrate network capabilities and remote and local storage, while DeLeo demonstrates images, even MPEG video, while Martin demonstrates digital music and use of a sound system.

With regard to Claim 26, Martin teaches periodic downloading of digital content. See (Col. 5, line 66 – Col. 6, line 2)

With regard to 27-30, the Examiner observes that the type of digital material that is contemplated in the present application carries very little patentable weight. As such,

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these claims are rejected as being obvious modifications to a DeLeo/Martin combination.

With regard to Claim 31-35, DeLeo teaches every aspect of an ATM configured to perform a variety of transactions, including debiting/crediting of user accounts. Further, Martin teaches the idea of a digital jukebox, necessitating collection of payment for content. A combination of the references teaches these claims.

With regard to Claims 36-44, each of these claims relate to a portable computing device configured for restricted access. These claims are taught by Lotspiech, which embodies these claims in a rental system of digital content. As such, DeLeo in view of Martin, and further in view of Lotspiech anticipates these claims.

With regard to Claims 45-48, these claims relate to a sound system with music video. Given that DeLeo discloses MPEG videos, these claims are rejected under the same analysis as Claims 3-6.

With regard to Claims 49-50, none of the cases heretofore cited specifically discloses printing out the digital content. However, DeLeo does disclose printing records and other data at (Col. 2, lines 16-27). As such these claims present an obvious modification to Leo to print out digital content.

With regard to Claims 51-52, these features relating to charging fees to a restaurant owner are an inherent aspect to any jukebox playing copyrighted material. As such a DeLeo/Martin combination would anticipate these claims.

With regard to Claims 53-54, these claims, related to a currency acceptance, are rejected under the same analysis as Claim 7.

With regard to Claims 55-76,82 these claims are method steps (except 82), which the apparatus of the previous claims are apparently designed to implement (see the 112 rejections above). They are rejected in the same manner as in the previous claims.

With regard to Claim 77, no reference heretofore discussed discloses biometric technology. However, biometric technology has been under development for several years now, and to add a feature that includes a biometric input, is simply put, an obvious modification to the apparatus and methods previously discussed. That is to say, the present application relates to a ATM/jukebox, not to advancing biometric technology.

With regard to Claims 78-81, these claims are method steps that the apparatus of the previous claims are apparently designed to implement (see the 112 rejections above). They are rejected in the same manner as in the previous claims.

With regard to Claims 83-84, these claims relate to fees, and are rejected in the same manner as those claims relating to accepting currency. That is to say, it is very clear in Martin that fees are required in order to access the networked jukebox. These claims are defeated by a DeLeo/Martin combination.

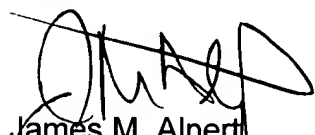
With regard to Claim 85-86, these claims presents no significant difference over an ATM machine as described in DeLeo combined with the jukebox in Martin. DeLeo discloses a cash dispensing machine operative to dispense digital files. Martin comprises a device capable of file selection.

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Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


James M. Alpert
October 11, 2005

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